

REMARKS

Claims 1-16 were pending in the application. Claims 4-6 and 9-16 have been withdrawn pursuant to a restriction requirement. Applicants may wish to file additional applications with claims reciting the non-elected subject matter in claims 4-6 and 9-16.

Applicants cancelled claim 1 and added new claims 17-26. Therefore claims 2-3, 7-8, and 17-26 are before the Office for examination. Claim 1 was a Markush claim and the newly added claims correspond to many of the elements previously recited in claim 1. The newly added claims find support throughout the specification as filed, especially in originally filed claim 1. Additionally, Applicants added claims recited stringency conditions for hybridization-type claims. These conditions may be found on page 12, lines 10-29, in the specification.

Abstract

Applicants submit herewith a replacement Abstract to cure the formalities raised by the Office.

Claim Objections

Applicants amended claim 7 to depend from elected subject matter.

Deposit Information

The subject matter having ATCC accession numbers PTA-4454 and PTA-4803 was deposited under the terms of the Budapest Treaty. The deposited subject matter will be irrevocably and without restriction released to the public upon issuance of a patent issuing from the instant application.

§112, Second Paragraph

The Office's §112, second paragraph positions are moot in view of Applicants' claim amendments.

§112, First Paragraph (Enablement & Written Description)

The Office maintains that claims 1-3 and 7-8 do not comply with the provisions of §112, first paragraph. To the extent that the Office maintains its position in view of the claims as amended, Applicants respectfully traverse the Office's positions.

The newly added claims appear to resolve the §112, enablement position raised by the Office on pages 5-6 of the Office Action. With respect to the Office's position concerning hybridization conditions, beginning on the bottom of page 6, and continuing

D0297 NP

on page 7, Applicants respectfully traverse. The Office fails to advance any evidence of unpredictability in the art, as of the filing date of the instant application. Conditions concerning hybridization of nucleic acid fragments were well known in the art as of January 2004 (the filing date of the instant application). Nonetheless, in Applicants' newly added claims, conditions are provided regarding hybridization, although Applicants submit that the Office has failed to submit sufficient evidence to sustain the legal conclusion of 'undue experimentation.'

The Office's §112 written description and enablement positions beginning on the bottom of page 7 and continuing to page 11, are moot in view of the claim amendments.

§102 Positions

Applicants amendments to the claims overcome the rejections under §102(e) in view of Lardizabal and Attersand. These references fail to teach each element of the claims as amended.

The Office rejected claims 1-3, 7 and 8 over Gimeno under §102(e). Applicants note that as of April 6, 2006 Gimeno (Application No. 10/324618) has been abandoned, thus the claims do not appear to be patentable to Gimeno. Submitted herewith is a declaration under 37 C.F.R. §1.131 of one of the named inventors establishing that Applicants actually reduced to practice the MGAT3 sequence prior to the December 19, 2002 filing date of Gimeno.

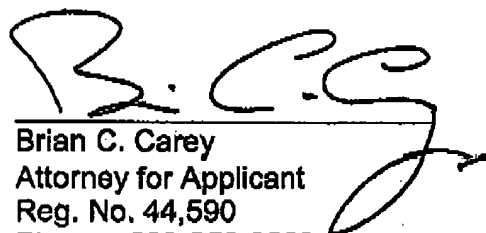
In view of the foregoing, Applicants submit that the claims are in condition for allowance.

Should the Office wish to discuss the above further, please contact the undersigned.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000

Date: November 16, 2006


Brian C. Carey
Attorney for Applicant
Reg. No. 44,590
Phone: 609-252-3883